



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,659	03/12/2001	Derk J. Hogenkamp	1861.1260001/JMC/THN	6633

26111 7590 11/26/2001

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON, DC 20005-3934

EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT PAPER NUMBER

1624

DATE MAILED: 11/26/2001

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/803,659

Applicant(s)
HOGENKAMP ET AL.

Examiner
Venkataraman Balasubramanian

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 24, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-58 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

DETAILED ACTION

Applicants' preliminary amendment, filed on 9/24/2001, is made of record.

Claims 1-58 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-51, drawn to compound of formula II where A_1 and A_2 or A_2 and A_3 are nitrogens and the other CR_2 , namely 1,2,4-triazine and pharmaceutical composition, classified in class 544, subclass 182, class 514, subclass 242.
- II. Claims 1-51, drawn to compound of formula II where A_1 and A_3 are nitrogens and the other CR_2 , namely 1,3,5-triazine and pharmaceutical composition classified in class 544, subclasses 204, 213, 217 and 218, class 514, subclass 241.
- III. Claims 1-51, drawn to compound of formula II where A_1 or A_3 is nitrogen and the other two groups are CR_2 , namely pyrimidine and pharmaceutical composition, classified in class 544, subclasses 298, 315, 316, 319, 323, 326, class 514, subclasses 256 and 269.
- IV. Claims 1-51, drawn to compound of formula II where A_2 is nitrogen and A_1 and A_3 are CR_2 , namely pyrazine and pharmaceutical composition, classified in class 544, subclass 336 and 408, class 514, subclass 252.10.

Art Unit: 1624

- V. Claims 1-51, drawn to compound of formula II where A_1 , A_2 and A_3 are CR_2 , namely pyridine and pharmaceutical composition, classified in class 546, subclasses 290, 296 and 297, class 514, subclass 277.
- VI. Claims 52-58, drawn to various method of use of the compound of formula II and others, classified in class 514, subclasses various depending upon the choice of A_1 , A_2 and A_3 .

The inventions are distinct, each from the other because of the following reasons:

The inventions of the Group I -VII are independent and distinct from each other because they are directed to structurally dissimilar compounds that lack common structural core namely 1,2,4-triazine vs 1,3,5-triazine vs pyrimidine vs pyrazine vs pyridine. Consequently, the groups have different classifications and require separate prior art searches. They can be made and used independently. Art which may render obvious or anticipate one of the groups would not necessarily do the same for the other group. Each can support a patent as the compounds of each group are capable of being utilized alone not in combination with other members listed in the Markush group.

Inventions I-V and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the process for using the product as claimed can be practiced with another materially different product such as isomeric triazines, pyrimidines, pyrazines or pyridines. There is no required

combination as each of the inventions can be made and used independent of each other. Similarly, the product as claimed can be used in a materially different process of using that product as evidenced by multiple method of use for treating and or preventing diseases stated in claim 54 and prior art referred to in specification on pages 2-4.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention: See claims 39 and 40.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, 1-38 and 41-58 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Art Unit: 1624

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Due to distinct nature of each invention, the restriction is set forth in writing.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.30 AM to 5.00 PM.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Application/Control Number: 09/803,659

Page 6

Art Unit: 1624

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

11/17/2001